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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,178	09/22/2003	Satoru Saigo	242953US8	8776

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2451

NOTIFICATION DATE	DELIVERY MODE
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12/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/666,178

Applicant(s)

SAIGO ET AL.

Examiner

KAREN C. TANG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 11-17, 19 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 18, 20, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

- A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/30/08 has been entered.
- Claims 1-23 are presented for further examination.
- Group II Claims 8-10, 18, 20, 21, and 23 are elected without traversed.
- Group I Claims 1-7, 11-17, 19, and 22 are withdrawn.
- Claims 8, 18 and 21 are currently amended.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Okuyama fails to disclose the claimed limitations.

Examiner disagrees.

It is the combination of Okuyama and Staack disclose the claimed limitations:

notification reception means for receiving notification, transmitted from a relay device (service detection part 22), concerning detection of a client terminal is in a communicable state with the network (detects an connection or present information, refer to 0076), when the client terminal connects to another information transmission device through the network and uses a

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service provided through the connection (refer to 0076 and 0014); and information transmission means for transmitting undelivered information to the client terminal, provided that the notification reception means receives the notification (refer to 0005); and information transmission means for transmitting undelivered information to the client terminal, provided that the notification reception means receives the notification (refer to 0005).

Although Okuyama disclosed the invention substantially as claimed, Obuyama did not explicitly indicating that “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal.”

Staack, in analogous art, disclosing that “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal (refer to page 17, Lines 10-15).”

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Okuyama and Staack because Staack’s teaching of “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal” would improve the Okuyama’s system efficiency by enhanced messaging capabilities by reduce the signaling and traffic load necessary for transmitting and handling messages.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-10 and 18, 20, 21, 23 are rejected under 35 U.S.C. 101 because although the specification has not explicitly disclosing what a "unit" is, but according to the IEEE dictionary, the term "unit" could be considered as "a logically separable part of a computer program" to the one of the ordinary skill in the art. Therefore, "information transmission device" comprising a notification reception unit, and an information transmission unit (i.e., software) does not include any hardware structure, therefore, an "information transmission device" (i.e., machine) comprising software is considered as program per se, which is not one of the categories of statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 and 18, 20, 21, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama (EP 1102443) in view of Staack et al hereinafter Staack (WO 02/07396).

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1. Referring to Claim 8, Okuyama discloses an information transmission device comprising: notification reception means for receiving notification, transmitted from a relay device (service detection part 22), concerning detection of a client terminal is in a communicable state with the network (detects an connection or present information, refer to 0076), when the client terminal connects to another information transmission device through the network and uses a service provided through the connection (refer to 0076 and 0014); and information transmission means for transmitting undelivered information to the client terminal, provided that the notification reception means receives the notification (refer to 0005); and information transmission means for transmitting undelivered information to the client terminal, provided that the notification reception means receives the notification (refer to 0005).

Although Okuyama disclosed the invention substantially as claimed, Obuyama did not explicitly indicating that “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal.”

Staack, in analogous art, disclosing that “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal (refer to page 17, Lines 10-15).”

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Okuyama and Staack because Staack’s teaching of “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal” would improve the Okuyama’s system

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efficiency by enhanced messaging capabilities by reduce the signaling and traffic load necessary for transmitting and handling messages.

2. Referring to Claim 18, Okuyama discloses an information transmission device, comprising: a notification reception unit configured to receive a notification, transmitted from a relay device (service detection part 22), concerning detection of a client terminal that is in a communicable state with a network (detects an connection or present information, refer to 0076), when the client terminal connects to another information transmission device through the network and uses a service provided through the connection (refer to 0076); and information transmission units configured to transmit undelivered information to the client terminal, provided that the notification reception unit receives the notification (refer to 0005);

Although Okuyama disclosed the invention substantially as claimed, Obuyama did not explicitly indicating that “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal.”

Staack, in analogous art, disclosing that “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal (refer to page 17, Lines 10-15).”

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Okuyama and Staack because Staack’s teaching of “transmitting the undelivered information to the relay device if a transmission of the undelivered information, to the client terminal, is not received by the client terminal” would improve the Okuyama’s system

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efficiency by enhanced messaging capabilities by reduce the signaling and traffic load necessary for transmitting and handling messages.

3. Referring to Claim 9, Okuyama disclosed the information transmission device according to claim 8, Okuyama further discloses wherein the information transmission means selects the undelivered information to be transmitted to the client terminal from information stored in transmission information storage means (refer to 0093-0095), provided that the connection detection means detects the client terminal is in a communicable state with the network, and transmits the selected undelivered information to the client terminal (refer to 0079 and 0093-0095);

4. Referring to Claim 10, Okuyama and Staack disclosed the information transmission device according to claim 8, Okuyama further discloses wherein the notification reception means receives transmission related information required to transmit information to the client terminal (refer to 0073), and the information transmission means transmits the undelivered information to the client terminal, provided that the notification reception means receives the transmission related information (refer to 0005).

5. Referring to Claim 20, Okuyama and Staack disclosed the information transmission device according to claim 8, Okuyama further discloses undelivered information storage means for storing undelivered information, wherein the information transmission means selects the

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undelivered information from the undelivered information storage means and transmits the selected undelivered information to the client terminal (refer to 0142).

6. Referring to Claim 21, Okuyama and Staack disclosed the information transmission device according to claim 11, Okuyama further discloses storing the undelivered information in undelivered information storage means (refer to 0142); and selecting the undelivered information from the undelivered information storage means, wherein the transmitting, by use of the information transmission device including the information transmission means, comprises transmitting by use of the information transmission means, the selected undelivered information to the client terminal (refer to 0142).

7. Referring to Claim 23, Okuyama and Staack disclosed the information transmission device according to claim 18, Okuyama further discloses an undelivered information storage unit configured to store the undelivered information (refer to 0093-0095), wherein the information transmission unit is configured to select the undelivered information from the undelivered information storage unit and to transmit the selected undelivered information to the client terminal (refer to 0142);

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

Vaananen (US 2007/0190987) "Voicemail short message service method and means and a subscriber terminal" disclosing a method and means for instantaneous packet switched voicemail between Internet compatible computers, personal digital assistants, telephones and mobile stations. In particular the inventive subscriber terminal (500) concerns a hardware and a software setup that allows the combined use of audio and/or video devices (550) with both the normal cellular or fixed telephony network (520) and with an Internet connection (510).

Cazier et al (US 2003/0110224) "Message auto-routing for electronic mail" disclosing the auto-routing electronic mail system compares a received e-mail message to previously sent e-mail messages. If a match occurs, the e-mail system determines that the previously sent e-mail message is a bounced e-mail message.

Boyle et al (US 6,119,167) "Pushing and Pulling data in Networks" disclosing a method for processing data pushed over a network from a data source or sources to a data destination or

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destinations via a computer system intermediate between the source or sources and the destination or destinations, wherein the intermediate computer system communicates with the source or sources and destination or destinations over the network, the method comprising the intermediate computer system receiving data being pushed from a data source to a data destination DE1 if the intermediate computer system is unable to forward the pushed data to the destination DE1 for a predetermined length of time, then the intermediate computer system deleting the pushed data and never forwarding the pushed data to the destination DE1.

Examiner's Notes: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karen C Tang/

Examiner, Art Unit 2451